The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIGHT L. ENGWALL, CHRIS J. MORROW, KEVIN J. STEEN, and ROGER A. JOHNSON

Appeal No. 2003-2058
Application No. 09/407,278

ON BRIEF

Before GARRIS, OWENS, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 17, 18 and 28 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of manufacturing a composite part on a hybrid tool wherein a face sheet of the hybrid tool is made from a composite material made

on a master tool. Further details of this appealed subject matter are set forth in representative independent claim 17 which reads as follows:

17. A method of manufacturing a composite part on a hybrid tool, comprising:

coating a face sheet of a hybrid tool with a release agent, said face sheet made from a composite material made on a master tool, the composite material having a mold surface the same shape and size as a surface of said part;

laying up plies of resin impregnated fabric material on said face sheet to a desired thickness;

debulking said plies in a vacuum bag with gas pressure, and curing said resin to form said part on said face sheet;

placing said hybrid tool on a machine tool bed at a position designated in a machine tool program using positioning devices;

probing reference features on said hybrid tool to accurately establish the position of said face sheet relative to a home position of the machine tool, said reference features having been transferred from corresponding reference feature on said master tool;

normalizing said machine tool part program to correspond to the actual position of the hybrid tool on the machine tool bed as determined by said probing of said hybrid tool reference features;

operating the machine tool to rotate a cutting tool while following a cutting path along and within a groove in said face sheet so that said cutting tool projects into said groove and engages the full thickness of said laid-up part on said hybrid tool face sheet for peripheral edge trimming of the part; and

removing the trimmed part from the mold surface.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Carver et al. (Carver)	4,937,768	Jun. 26, 1990
Engwall	5,746,553	May 5, 1998 (filed Apr. 8, 1996)

All of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwall in view of Carver.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

For the reasons set forth in the answer and below, we will sustain this rejection.

The sole claim-distinction argument advanced by the appellants on this appeal is that the "tool [of Engwall] uses an Invar metal forming surface, so *Engwall* fails to teach or to suggest a tool having a composite material as the mold surface" and correspondingly that "*Carver* fails to cure the deficiencies of *Engwall*" (brief, page 3). As correctly indicated in the answer, however, this argument is based on a clearly erroneous premise. That is, contrary to the appellants' apparent belief, Engwall explicitly teaches using a composite material in forming

a mold surface of his tool (e.g., see lines 61-67 in column 3) as repeatedly explained by the examiner. It follows that the argument under consideration lacks persuasive merit.

In addition to the foregoing, the appellants argue that the Engwall patent is not available as prior art with respect to the here claimed subject matter. This argument is not convincing for the reasons thoroughly explained in the answer. Engwall is available as prior art in the examiner's section 103 rejection via 35 U.S.C. § 102(e). See Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 147 USPQ 429, 430 (1965) and the Manual of Patent Examining Procedure (MPEP) § 2136.02 (Rev. 1, Feb. 2003). Moreover, the Engwall patent is available as prior art notwithstanding apparently common ownership with respect to the present application because the prior art disqualification provisions of 35 U.S.C. § 103(c) are not applicable to utility patent applications of the type under consideration which were filed before November 29, 1999. See MPEP § 706.02(l)(1).

In response to the examiner's exposition of this last mentioned point, the appellants state that, "[i]f this application had a filing date after November 29, 1999, (which it could have, quite simply, by filing a Request for Continued

Examination[1]), [sic] *Engwall* would not be a [prior art] reference" (reply brief, page 3). We recognize that Engwall may be avoided as prior art under § 103(c) under the circumstances explained in MPEP §§ 706.02(l)(1) through 706.02(l)(3). Nevertheless, the fact remains that such circumstances do not presently exist in the application before us on this appeal. Thus, the Engwall patent is available as prior art with respect to the subject matter defined by the appealed claims of this application.

For the reasons set forth above and in the answer, we hereby sustain the examiner's section 103 rejection of all appealed claims as being unpatentable over Engwall in view of Carver.

The decision of the examiner is affirmed.

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[1] As a matter of clarification, the appellants are unquestionably incorrect in believing that a Request for Continued Examination under 37 CFR § 1.114 would somehow avoid Engwall as a prior art reference. See the MPEP at § 706.02(l)(1), particularly the last full paragraph in the right hand column on page 700-50.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris
Administrative Patent Judge

Terry J. Owens
Administrative Patent Judge

Catherine Timm
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

BRG:tdl

John C. Hammar
The Boeing Company
P.O. Box 3707 MC 13-08
Seattle, WA 98124-2207